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ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

LYLES IRVING, CARMEN V

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,584

Applicant(s)

CLARK ET AL.

Examiner

Carmen Lyles-Irving

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/26/89 & 9/30/04; 05/05+8/04/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because it is not clear in the drawings that the portion of the filter that is crimped is in a generally cross-shaped form in accordance with claim 15. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 15 teaches that a central portion of the filter is crimped along an axial direction into a generally cross-shaped form. The specification fails to teach the filter being crimped in a cross-shaped manner.

Claim Objections

Claim 17 is objected to because of the following informalities: the specification teaches the inner portion of the filter being crimped to hold the capsule whereas claim 17 teaches that a central portion of the filter is crimped. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitation "inner central portion" in reference to the central portion of the filter material. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno et al (U.S. Patent No. 4,889,144) in view of Arterbery (U.S. Patent No. 5,746,230). Regarding claims 1 and 2, Tateno teaches a cigarette comprising a tobacco rod and a filter element connected to the tobacco rod, said filter element having an end proximal to the tobacco rod and an end distal from the tobacco rod, wherein said filter element comprises a first longitudinally extending section of filter material positioned at the end of the filter segment distal from the tobacco rod; and at least one breakable capsule contained within said first section of filter material (Figures 2 and 3; column 1, lines 58-62). Tateno fails to teach an adsorbent material positioned between

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said first section of filter material and said tobacco rod as well as said filter element further comprising a second longitudinally extending section of filter material positioned between said first section of filter material and said tobacco rod, said adsorbent material being dispersed within said second section of filter material. However, Arterbery teaches that is conventional in the art to have a cigarette filter made of two plugs placed end-to-end with a space in between, the space being filled with a material such as charcoal (an adsorbent) (column 1, lines 21-24). It would have been obvious to one of ordinary skill in the art at the time invention to combine the teaching of Tatenno with the teaching of Arterbery to provide such filters having multiple plugs abutting one another, the different plugs differing in density or other characteristics (column 1, lines 24-27). Accordingly, claims 1 and 2 are rejected.

Regarding claims 3 and 6, Arterbery teaches the first section of filter material and said second section of filter material are each independently selected from cellulose acetate tow (column 1, lines 38-40). Accordingly, claims 3 and 6 are rejected.

Regarding claim 5, Arterbery teaches said filter element further comprises a second longitudinally extending section of filter material positioned at the other end of the filter element proximal to the tobacco rod and spaced apart from said first section of filter material, the two sections of filter material defining a compartment therebetween, said adsorbent material being contained within at least a portion of said compartment between said first and said second sections of filter material (column 21-24). Accordingly, claim 5 is rejected.

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Regarding claims 8 and 9, due to a lack of criticality and unexpected results, it would have been obvious to one of ordinary skill at the time of the invention to use a filter length of a length necessary to achieve the desired product. Accordingly, claims 8 and 9 are rejected.

Regarding claim 15, Tateno teaches a longitudinally extending central portion of filter material and a compartment having a structure defined by the inner central portion, wherein said breakable capsule is contained with said compartment (Figs. 1 and 3). Tateno does not expressly teach a longitudinally extending outer portion of filter material positioned annularly around a central portion. However, it would have been obvious to one of ordinary skill in the art for there to be filter material positioned annularly around the central portion of the filter in order to support the flavor capsules. Accordingly, claim 15 is rejected.

Regarding claim 16, Arterbery teaches the central portion and the outer portion of said filter section of filter material to comprise cellulose acetate tow (column 1, lines 38-40). Accordingly, claim 16 is rejected.

Regarding claims 18 and 19, Tateno teaches the breakable capsule contains a flavorant capable to altering the overall composition of the mainstream smoke generated by the cigarette (column 1, lines 58-60). Accordingly, claims 18 and 19 are rejected.

Regarding claim 20, Tateno teaches the capsule is generally spherical in shape (column 6, lines 49-52). Accordingly, claim 20 is rejected.

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Regarding claim 21, Tateno teaches a breakable capsule comprising an outer gelatin shell; and an inner liquid composition contained in the outer gelatin shell, the inner liquid composition including at least one flavoring agent (column 2, lines 35-38 and 41-50) and at least one diluting agent (column 2, lines 51-54). Accordingly, claim 21 is rejected.

Regarding claims 24 and 25, due to a lack of criticality and unexpected results, it would have been obvious to one of ordinary skill at the time of the invention to use a capsule with a diameter of sufficient size, including a diameter of at least about 3 mm and less than about 5 mm, to hold enough flavorant to deodorize the mainstream smoke generate by the cigarette. Accordingly, claims 24 and 25 are rejected.

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno and Arterbery as applied to claims 1 and 2 above, and further in view of Keith et al (U.S. Patent No. 3,460,543). Tateno and Arterbery fail to teach said first section of filter and said second section of filter material comprise plasticized cellulose acetate tow. However, Keith teaches it is conventional in the art for filter plug to be comprise plasticized cellulose acetate tow. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Tateno and Arterbery with the teaching of Keith to produce a filter with adsorbent materials to remove unwanted compositions from cigarette smoke (column 6, lines 30-35). Accordingly, claim 4 is rejected.

Claims 10, 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno and Arterbery as applied to claims 1 and 2 above, and further

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in view of Wise et al (U.S. Patent No. 3,658,069). Regarding claims 10, 11 and 13, Arterbury teaches the adsorbent is charcoal. Arterbury fails to teach that the charcoal is activated. However, Wise teaches it is conventional in the art to add activated charcoal (carbon) components in granular form to remove carbon monoxide in tobacco smoke (column 49-52 and column 2, lines 16-17). It would have been obvious to one of ordinary skill in the art at the time invention to combine the teachings of Tateno and Arterbury with the teachings of Wise to provide such filters having multiple plugs abutting one another, the different plugs differing in density or other characteristics (column 1, lines 24-27). Accordingly, claims 10, 11 and 13 are rejected.

Regarding claim 14, Wise shows it is conventional in the art to use an adsorbent that has a particle size of about 8x16 mesh to about 30x70 mesh (column 2, lines 15-19). Accordingly, claim 14 is rejected.

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno, Arterbury and Wise et al as applied to claims 10, 11, 13 and 14 above, and further in view of Frund (U.S. Patent No. 3,658,069). Tateno, Arterbury and Wise fail to teach that the activated carbon has an activity of about 60 to about 150 Carbon Tetrachloride Activity. However, Frund teaches the use of an activated carbon that has a carbon tetrachloride activity of at least 95. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tateno, Arterbury and Wise with the teachings of Frund to produce a filter capable of filtering toxic agents. Accordingly, claim 12 is rejected.

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Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno and Arterbery as applied to claims 1 and 2 above, and further in view of Lake et al (U.S. Patent No. 2,231,076). Tateno and Arterbery fail to teach that the central portion of the filter is crimped along an axial direction into a generally cross-shaped form. However, Lake teaches the use of a gas filter that is cross-shaped. Although, Lake's teaching is directed to a gas service filter and not to a cigarette, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tateno and Arterbery with the teaching of Lake to design a cross-shaped cigarette filter that is crimped for the filtering of gas, i.e. smoke, in order to remove foreign matter. Accordingly, claim 17 is rejected.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno and Arterbery as applied to claims 1 and 2 above, and further in view of www.dictionary.com and Saka et al (U.S. Patent No. 5,977,346). Tateno and Arterbery fail to teach the use of a diluting agent that is a medium chain triglyceride mixture. However, www.dictionary.com (website last updated on January 26, 2005) teaches that a triglyceride is a naturally occurring ester of three fatty acids and glycerol that is the chief constituent of fats and oils. Moreover, Saka teaches the use of a fatty acid ester of a cellulose as a diluent (Abstract; column 1, lines 26-30). Although, Saka does not teach the use of a medium chain triglyceride mixture as a diluting agent, it would have been obvious to one of ordinary skill in the art at the time of the invention that one fatty ester could be substituted for another to be used as a diluting agent. Accordingly, claim 22 is rejected.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno and Arterbery as applied to claims 1 and 2 above, and further in view of Schultz et al (U.S. Patent No. 3,370,592). Tateno and Arterbery fail to teach a tipping material connecting the tobacco rod and the filter element, wherein said tipping material includes a visual indicator of the position of the capsule within the filter element. Schultz teaches a cigarette with a tipping material connecting the tobacco rod and the filter element, wherein said tipping material includes a visual indicator (an opening – reference 21 in Figure 1) so that the filter is visible. Schultz fails to teach a visual indicator specifically for the viewing of the capsule within the filter element. However, it would have been obvious to one of ordinary skill at the time of the invention to combine the teachings of Tateno and Arterbery with the teachings of Schultz to design a cigarette with a visual indicator enabling the user to see the capsules in the filter element. Accordingly, claim 23 is rejected.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno and Arterbery as applied to claims 1 and 2 above, and further in view of www.dictionary.com. Tateno teaches that the flavorant in the capsules is menthol (column 4, lines 39-40). Methol is obtained from peppermint oil (a breath freshener) and is used as a mint flavoring as evidenced by www.dictionary.com (websites last updated January 26, 2005). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tateno and Arterbery with the teachings of www.dictionary.com to invent a cigarette that not only

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flavors the cigarette smoke, but that also freshens the breath of the user to make it more pleasant. Accordingly, claim 26 is rejected.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tateno et al (U.S. Patent No. 4,889,144) in view of Arterbery (U.S. Patent No. 5,746,230) and Wise et al (U.S. Patent No. 3,658,069). Tateno teaches a cigarette comprising a tobacco rod and a filter element connected to the tobacco rod, said filter element having an end proximal to the tobacco rod and an end distal from the tobacco rod, wherein said filter element comprises: a first longitudinally extending section of filter material positioned at the end of the filter element distal from the tobacco rod, said first section of filter material comprising a longitudinally extending central portion of filter material (Figs. 1 and 3), a compartment having a structure defined by the inner central portion, and at least one breakable capsule positioned in the compartment in said first section of filter material (Figures 2 and 3; column 1, lines 58-62). Tateno does not expressly teach a longitudinally extending outer portion of filter material positioned annularly around a central portion. However, it would have been obvious to one of ordinary skill in the art for there to be filter material positioned annularly around the central portion of the filter in order to support the flavor capsules.

Tateno fails to teach a second longitudinally extending section of filter material positioned at the end of the filter element proximal to the tobacco rod and spaced apart from said first section of filter material, the two sections of filter material defining a compartment therebetween. However, Arterbery teaches that is conventional in the art to have a cigarette filter made of two plugs placed end-to-end with a space in between,

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the space being filled with a material such as charcoal (an adsorbent) (column 1, lines 21-24). It would have been obvious to one of ordinary skill in the art at the time invention to combine the teaching of Tateno with the teaching of Arterbery to provide such filters having multiple plugs abutting one another, the different plugs differing in density or other characteristics (column 1, lines 24-27).

Tateno and Arterbery fail to teach an adsorbent material in granular form contained within at least a portion of the compartment between said first section of filter material and said second section of filter material. However, Wise teaches it is conventional in the art to add activated charcoal components in granular form to remove carbon monoxide in tobacco smoke (column 49-52 and column 2, lines 16-17). It would have been obvious to one of ordinary skill in the art at the time invention to combine the teaching of Tateno and Arterbery with the teaching of Wise to provide filters having multiple plugs abutting one another, the different plugs differing in density or other characteristics (column 1, lines 24-27). Accordingly, claim 27 is rejected.

Claims 1-3 and 15-26 are rejected under 35 U.S.C. 103(a) as being obvious over Dube et al (U.S. PG Pub. 2004/0261807) in view of Arterbery et al (U.S. Patent No. 5,746,230. Regarding claim 1, Dube teaches a cigarette comprising a tobacco rod and a filter element connected to the tobacco rod, said filter element having an end proximal to the tobacco rod and an end distal from the tobacco rod, wherein said filter element comprises: a first longitudinally extending section of the filter material positioned at the end of the filter element distal from the tobacco rod; and at least one breakable capsule contained within said first section of filter material (claims 1, 5 and 26). Dube fails to

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teach an adsorbent material positioned between the first section of filter material and said tobacco rod. However, Arterbery teaches that is conventional in the art to have a cigarette filter made of two plugs placed end-to-end with a space in between, the space being filled with a material such as charcoal (an adsorbent) (column 1, lines 21-24). It would have been obvious to one of ordinary skill in the art at the time invention to combine the teaching of Dube with the teaching of Arterbery to provide such filters having multiple plugs abutting one another, the different plugs differing in density or other characteristics (column 1, lines 24-27). Accordingly, claim 1 is rejected.

Regarding claim 2, Dube teaches the filter element further comprises a second longitudinally extending section of filter material positioned between said first section of filter material and said tobacco rod, said adsorbent material being dispersed within said second material of filter material (claim 18). Accordingly, claim 2 is rejected.

Regarding claim 3, Dube teaches said first section of filter material and said second section of filter material are each independently selected from the group consisting of cellulose acetate tow, gathered cellulose acetate web, polypropylene tow, gathered polypropylene web, gathered polyester web, gathered paper, and strands of reconstituted tobacco (claim 40). Accordingly, claim 3 is rejected.

Regarding claim 15, Dube teaches said first section of filter material comprises: a longitudinally extending central portion of filter material; a longitudinally extending outer portion of filter material positioned annularly around the central portion; and a compartment having a structure defined by the inner central portion, wherein said

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breakable capsule is contained with said compartment (claims 2 and 24). Accordingly, claim 15 is rejected.

Regarding claim 16, Dube teaches the central portion and the outer portion of said first section of filter material comprises cellulose acetate tow (claims 15, 17, 35 and 37). Accordingly, claim 16 is rejected.

Regarding claim 17, Dube teaches said central portion is crimped along an axial direction into a generally cross-shaped form (claims 6 and 27). Accordingly, claim 17 is rejected.

Regarding claim 18, Dube teaches the breakable capsule contains a component capable of altering the overall composition of mainstream smoke generated by the cigarette (claims 8 and 29). Accordingly, claim 18 is rejected.

Regarding claim 19, Dube teaches the breakable capsule contains flavoring for mainstream smoke generated by the cigarette (claims 3 and 25). Accordingly, claim 19 is rejected.

Regarding claim 20, Dube teaches a capsule that is generally spherical in shape (claim 44). Accordingly, claim 20 is rejected.

Regarding claim 21, Dube teaches a breakable capsule comprising: an outer gelatin shell; and an inner liquid composition contained in the outer gelatin shell, the inner liquid composition including at least one flavoring agent and at least one diluting agent (claims 11 and 31). Accordingly, claim 21 is rejected.

Regarding claim 22, Dube teaches the diluting agent is a medium chain triglyceride mixture (claims 12, 46, and 32). Accordingly, claim 22 is rejected.

Regarding claim 23, Dube teaches a tipping material connecting the tobacco rod and the filter element, wherein said tipping material includes a visual indication of the position of the capsule within the filter element (claims 13 and 33). Accordingly, claim 23 is rejected.

Regarding claim 24, Dube teaches a capsule with a diameter of at least about 3 mm (claims 14 and 45). Accordingly, claim 24 is rejected.

Regarding claim 25, Dube teaches a capsule with a diameter of less than about 5 mm (claims 36 and 45). Accordingly, claim 25 is rejected.

Regarding claim 26, Dube teaches the breakable capsule contains a breath freshening agent (claim 21). Accordingly, claim 26 is rejected.

Claims 27 is rejected under 35 U.S.C. 103(a) as being obvious over Dube et al (U.S. PG Pub. 2004/0261807) in view of Arterbery et al (U.S. Patent No. 5,746,230) and Wise et al (U.S. Patent No. 3,658,069). Dube teaches a cigarette comprising a tobacco rod and a filter element connect to the tobacco rod, said filter element having an end proximal to the tobacco rod and an end distal from the tobacco rod, wherein said filter element comprises: a first filter segment connect to the tobacco rod, said first filter segment having an end proximal to the tobacco rod and an end distal from the tobacco rod; a cavity extending into the first filter segment from the end of the first filter segment distal from the tobacco rod; a second filter element positioned at the end of the filter element distal from the tobacco rod; and a breakable capsule disposed in the cavity, wherein said capsule has a diameter of at least about 3 mm (claim 23). The first filter also comprises a longitudinally extending central portion; a longitudinally extending

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outer portion of filter material positioned annularly around the central portion (claim 24). Despite the fact that the Dube filter's first section is positioned closest to the tobacco, it would have been obvious to one of ordinary skill that the filter portion with the cavity could be positioned distal from the tobacco rod as it is in the instant invention because the position of the cavity is not critical to the functioning of the product.

Dube fails to teach an adsorbent material in granular form positioned within at least a portion of the compartment between said first section of filter material and said second section of filter material. However, Arterbery teaches that is conventional in the art to have a cigarette filter made of two plugs placed end-to-end with a space in between, the space being filled with a material such as charcoal (column 1, lines 21-24). Likewise, Wise teaches it is conventional in the art to add activated charcoal components in granular form to remove carbon monoxide in tobacco smoke (column 49-52 and column 2, lines 16-17). It would have been obvious to one of ordinary skill in the art at the time invention to combine the teaching of Dube with the teachings of Arterbery and Wise to provide such filters having multiple plugs abutting one another, the different plugs differing in density or other characteristics (column 1, lines 24-27). Accordingly, claim 27 is rejected.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an

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invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Double Patenting

Claims 1-3 and 15-26 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5,6,8,11-18,21, 25, and 27-29, 31-40 and 44-46 of copending Application No. 10/600,712 in view of Arterbery (U.S. Patent No. 5,746,230). Regarding claim 1, Dube teaches a cigarette comprising a tobacco rod and a filter element connected to the tobacco rod, said filter element having an end proximal to the tobacco rod and an end distal from the tobacco rod, wherein said filter element comprises: a first longitudinally extending section of the filter material positioned at the end of the filter element distal from the tobacco rod; and at least one breakable capsule contained within said first section of filter material (claims 1, 5 and 26). Dube fails to teach an adsorbent material positioned between the first section of filter material and said tobacco rod. However, Arterbery teaches that is conventional in the art to have a cigarette filter made of two plugs placed end-to-end

with a space in between, the space being filled with a material such as charcoal (an adsorbent) (column 1, lines 21-24). It would have been obvious to one of ordinary skill in the art at the time invention to combine the teaching of Dube with the teaching of Arterbery to provide such filters having multiple plugs abutting one another, the different plugs differing in density or other characteristics (column 1, lines 24-27). Accordingly, claim 1 is rejected.

Regarding claim 2, Dube teaches the filter element further comprises a second longitudinally extending section of filter material positioned between said first section of filter material and said tobacco rod, said adsorbent material being dispersed within said second material of filter material (claim 18). Accordingly, claim 2 is rejected.

Regarding claim 3, Dube teaches said first section of filter material and said second section of filter material are each independently selected from the group consisting of cellulose acetate tow, gathered cellulose acetate web, polypropylene tow, gathered polypropylene web, gathered polyester web, gathered paper, and strands of reconstituted tobacco (claim 40). Accordingly, claim 3 is rejected.

Regarding claim 15, Dube teaches said first section of filter material comprises: a longitudinally extending central portion of filter material; a longitudinally extending outer portion of filter material positioned annularly around the central portion; and a compartment having a structure defined by the inner central portion, wherein said breakable capsule is contained within said compartment (claims 2 and 24). Accordingly, claim 15 is rejected.

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Regarding claim 16, Dube teaches the central portion and the outer portion of said first section of filter material comprises cellulose acetate tow (claims 15, 17, 35 and 37). Accordingly, claim 16 is rejected.

Regarding claim 17, Dube teaches said central portion is crimped along an axial direction into a generally cross-shaped form (claims 6 and 27). Accordingly, claim 17 is rejected.

Regarding claim 18, Dube teaches the breakable capsule contains a component capable of altering the overall composition of mainstream smoke generated by the cigarette (claims 8 and 29). Accordingly, claim 18 is rejected.

Regarding claim 19, Dube teaches the breakable capsule contains flavoring for mainstream smoke generated by the cigarette (claims 3 and 25). Accordingly, claim 19 is rejected.

Regarding claim 20, Dube teaches a capsule that is generally spherical in shape (claim 44). Accordingly, claim 20 is rejected.

Regarding claim 21, Dube teaches a breakable capsule comprising: an outer gelatin shell; and an inner liquid composition contained in the outer gelatin shell, the inner liquid composition including at least one flavoring agent and at least one diluting agent (claims 11 and 31). Accordingly, claim 21 is rejected.

Regarding claim 22, Dube teaches the diluting agent is a medium chain triglyceride mixture (claims 12, 46, and 32). Accordingly, claim 22 is rejected.

Regarding claim 23, Dube teaches a tipping material connecting the tobacco rod and the filter element, wherein said tipping material includes a visual indication of the

position of the capsule within the filter element (claims 13 and 33). Accordingly, claim 23 is rejected.

Regarding claim 24, Dube teaches a capsule with a diameter of at least about 3 mm (claims 14 and 45). Accordingly, claim 24 is rejected.

Regarding claim 25, Dube teaches a capsule with a diameter of less than about 5 mm (claims 36 and 45). Accordingly, claim 25 is rejected.

Regarding claim 26, Dube teaches the breakable capsule contains a breath freshening agent (claim 21). Accordingly, claim 26 is rejected.

This is a provisional obviousness-type double patenting rejection.

Claim 27 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23, 24 and 26 of copending Application No. 10/600,712 in view of Arterbery (U.S. Patent No. 5,746,230) and Wise et al (U.S. Patent No. 3,658,069). Dube teaches a cigarette comprising a tobacco rod and a filter element connect to the tobacco rod, said filter element having an end proximal to the tobacco rod and an end distal from the tobacco rod, wherein said filter element comprises: a first filter segment connect to the tobacco rod, said first filter segment having an end proximal to the tobacco rod and an end distal from the tobacco rod; a cavity extending into the first filter segment from the end of the first filter segment distal from the tobacco rod; a second filter element positioned at the end of the filter element distal from the tobacco rod; and a breakable capsule disposed in the cavity, wherein said capsule has a diameter of at least about 3 mm (claim 23). The first filter also comprises a longitudinally extending central portion; a longitudinally extending

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outer portion of filter material positioned annularly around the central portion (claim 24). Despite the fact that the Dube filter's first section is positioned closest to the tobacco, it would have been obvious to one of ordinary skill that the filter portion with the cavity could be positioned distal from the tobacco rod as it is in the instant invention because the position of the cavity is not critical to the functioning of the product.

Dube fails to teach an adsorbent material in granular form positioned within at least a portion of the compartment between said first section of filter material and said second section of filter material. However, Arterbery teaches that is conventional in the art to have a cigarette filter made of two plugs placed end-to-end with a space in between, the space being filled with a material such as charcoal (column 1, lines 21-24). Likewise, Wise teaches it is conventional in the art to add activated charcoal components in granular form to remove carbon monoxide in tobacco smoke (column 49-52 and column 2, lines 16-17). It would have been obvious to one of ordinary skill in the art at the time invention to combine the teaching of Dube with the teachings of Arterbery and Wise to provide such filters having multiple plugs abutting one another, the different plugs differing in density or other characteristics (column 1, lines 24-27). Accordingly, claim 27 is rejected.

Conclusion

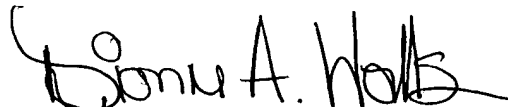
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen Lyles-Irving whose telephone number is (571) 272-2945. The examiner can normally be reached Monday through Friday from 8am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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CLI
09/17/2005


DIONNE A. WALLS
PRIMARY EXAMINER